

REMARKS

Applicants amended claims 1, 13 and 23, and cancelled claim 5. Claims 1-4, 6-17 and 20-27 are presented for examination.

The Examiner rejected independent claim 23 and its dependent claim 27 under 35 U.S.C. §102(b) as being anticipated by Fujimori. Applicants amended claim 23 to obviate this rejection, so the rejection should be withdrawn.

The Examiner rejected claims 1-15, 21 and 22 under 35 U.S.C. §103(a) as being unpatentable over Fujimori in view of Tiedje, alone or further in view of Nakamura.¹ But, as would be readily understood by one skilled in the art, Fujimori discloses only processes for making his device in which the semiconductor layer has the same general degree of structure as the substrate. As would also be understood by one skilled in the art, Tiedje also discloses only processes in which or making his device in which the semiconductor layer has the same general degree of structure as the substrate. Thus, even if Fujimori and Tiedje were somehow combined in the manner suggested by the Examiner, the result would be a device with a substrate having a surface with some degree of structure and a semiconductor having a surface with generally the same degree of structure. There is nothing in Fujimori or Tiedje that would have made it obvious to further modify such a device so that the semiconductor layer would have a planar surface. Referring to paragraph [0363] of Fujimori, the Examiner has said that "Fujimori discloses that the reference is open to any kind of modification without departing from the scope of the invention." (Final Office Action, p. 17, emphasis provided.) But, the Examiner mischaracterized paragraph [0363] of Fujimori. What this paragraph of Fujimori actually discloses is:

Finally, it is to be understood that the present invention is not limited to the embodiments and examples described above, and many changes or

¹ Applicants cancelled claim 5, so the rejection of this claim should be withdrawn.

additions may be made without departing from the scope of the invention which is determined by the following claims. (Fujimori, [0363], emphasis provided.)

Thus, what Fujimori actually discloses is quite different from what the Examiner said Fujimori discloses. The Examiner also said:

One reading Fujimori as a whole would have readily appreciated that the substrate or any other layer of [the] Fujimori's photoelectric conversion device can be structured or planar without departing from the scope of the invention as shown in [0363]. (Advisory Action, p. 2.)

But, as discussed above, when properly characterized, paragraph [0363] of Fujimori does not support the conclusion that Fujimori would have conveyed to one skilled in the art that "the substrate or any other layer .. can be structured or planar". Further, even if paragraph [0363] of Fujimori would have conveyed to one skilled in the art that any layer in his device could be structured or planar, neither Fujimori nor Tiedje, alone or in combination, would have enabled one skilled in the art to make a device with a substrate having surface that is structured and a semiconductor layer with a planar surface. Rather, as explained above, each of Fujimori and Tiedje disclose processes for making a device in which the surface of the semiconductor layer has the same general degree of structure as the surface of the substrate. Certainly, the very general nature of paragraph [0363] would not have enabled one skilled in the art to make a device with a substrate having surface that is structured and a semiconductor layer with a planar surface. However, for the prior art to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method. (*See, e.g., Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989) ("In order for the prior art to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.") Nakamura does not cure the deficiencies of the combination of Fujimori and/or Tiedje. Accordingly,

Applicants request reconsideration and withdrawal of the rejection of claims 1-4, 6-15, 21 and 22.

The Examiner rejected claims 23-25 and 27 under 35 U.S.C. §103(a) as being unpatentable over Fujimori in view of Tiedje, alone or further in view of Shinohara. These claims require: 1) an organic semiconductor having a surface that is planar; and 2.) a substrate having a surface that is structured and/or a support layer having a surface that is structured. For reasons similar to those noted above, the combination of Fujimori and Tiedje does not render obvious the subject matter covered by claims 23-25 and 27. Shinohara does not cure the deficiencies of Fujimori and Tiedje. Thus, Applicants request reconsideration and withdrawal of this rejection.

The Examiner rejected claims 16, 17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Fujimori in view of Shinohara. These claims require a first electrode having a surface that is structured, a first layer having a surface that is structured, a second layer having a surface that is planar, and an organic semiconductor having a surface that is planar. For reasons similar to those noted above, Fujimori does not disclose or render obvious the subject matter covered by these claims. Shinohara does not cure Fujimori's deficiencies. Applicants therefore request reconsideration and withdrawal of this rejection.

The Examiner rejected claims 23-26 under 35 U.S.C. §103(a) as being unpatentable over Fujimori in view of Shinohara, alone or further in view of Tiedje. These claims require: 1) an organic semiconductor having a surface that is planar; and 2.) a substrate having a surface that is structured and/or a support layer having a surface that is structured. For reasons similar to those noted above, Fujimori does not disclose or render obvious the subject matter covered by these claims. Neither Shinohara nor Tiedje, alone or in combination, cures Fujimori's deficiencies. Therefore, Applicants request reconsideration and withdrawal of this rejection.

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Respectfully submitted,

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